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11-04-2002

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Willie J. Ray
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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No.: 76/016,329
by KSL RECREATION CORPORATION
for the Mark: **KSL LA QUINTA NATIONAL GOLF CLUB**
Filed: April 3, 2000

Published in the Official Gazette
on June 18, 2002

La Quinta Worldwide, L.L.C.,
Opposer,
v.

KSL Recreation Corporation,
Applicant.

Opposition No. _____

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NOTICE OF OPPOSITION

BOX TTAB

FEE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Madam:

Opposer, La Quinta Worldwide, L.L.C., a Nevada limited liability company having a place of business at 909 Hidden Ridge, Suite 600, Irving, Texas 75038, believes that it may be damaged by registration of the mark shown in Application Serial No. 76/016,329 and hereby opposes the same.

11/12/2002 KGIBBONS 00000057 76016329

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As grounds of opposition, it is asserted:

1. Since at least as early as 1968, La Quinta Worldwide, LLC ("La Quinta") and its predecessors-in-interest have offered quality hotel and motel services in the United States under the mark LA QUINTA and under other design and word marks including the mark LA QUINTA (hereinafter referred to collectively as the "LA QUINTA Marks"). La Quinta began its hotel and motel operations in the southwestern United States and today has hotels or motels from coast to coast in more than thirty (30) states in the United States, including California. La Quinta has spent millions of dollars advertising and promoting its hotel and motel services under the LA QUINTA Marks. As a result of such efforts, and as a result of the long use by La Quinta of the LA QUINTA Marks, the LA QUINTA Marks are recognized as designations that identify and distinguish the quality hotel and motel services offered by La Quinta. Moreover, La Quinta has developed enormous goodwill in the LA QUINTA Marks for its hotel and motel services.

2. Consistent with its long use of the LA QUINTA Marks, La Quinta has obtained numerous federal registrations of its LA QUINTA Marks. Included among these registrations are the following:

MARK	REG. DATE	REG. NO.	GOODS/SERVICES
LA QUINTA (Stylized)	8/26/69	875,802	Motel services
LA QUINTA	12/27/77	1,080,641	Hotel/motel services
LA QUINTA INN and Design	6/29/82	1,199,980	Motel services
LA QUINTA MOTOR INNS and Design	5/13/86	1,393,579	Hotel/motel services
LA QUINTA BRAIN TRUST	2/17/87	1,429,660	Hotel/motel services
LA QUINTA INN and Design	4/25/89	1,536,926	Hotel/motel services
LA QUINTA INN and	2/22/94	1,823,440	Hotel/motel services

Design			
LA QUINTA INN and Design	6/21/94	1,841,032	Hotel/motel services

3. Declarations under Section 15 of the Lanham Act, 15 U.S.C. § 1065, have been filed with and accepted by the Patent and Trademark Office for each of the registrations listed above. The above registrations have therefore obtained "incontestable" status. Copies of these registrations are attached as Exhibit A.

4. On information and belief, Applicant, KSL Recreation Corporation, and an apparently related company, KSL Desert Resorts, Inc. (hereinafter collectively "KSL"), operate a destination golf course and country club resort in La Quinta, California under the name LA QUINTA RESORT AND CLUB.

5. On information and belief, KSL has never operated a resort property offering temporary lodging under the mark "La Quinta" outside of its property in La Quinta, California. KSL has never operated any other kind of property under the mark "La Quinta" that is located outside of its property in La Quinta, California.

6. On April 3, 2000, KSL Recreation Corporation filed an application to register the mark KSL LA QUINTA NATIONAL GOLF CLUB alleging an intent-to-use in commerce. The services recited in the application were "providing facilities for recreational activities, namely golf, tennis, swimming pools and spas; golf tournaments and instruction" in International Class 41 and "resort services, namely resort facilities, clubhouse and restaurant services" in International Class 42.

7. In the initial Office Action from the United States Patent and Trademark Office for this application, mailed September 18, 2000, the Examining Attorney of the United States Patent

and Trademark Office refused to register the mark under 15 U.S.C. § 1052(d) stating that KSL's mark, when used for KSL's identified services, "so resembles the marks in U.S. Registration Nos. 0,875,802, 1,080,641, 1,119,980, 1,393,578, 1,393,579, 1,42,660, 1,841,031, 1,841,032, 1,823,440, 2,055,687, 2,057,682, 2,147,965, 2,342,039, 2,300,509 2,298,693, 2,367,741 and 2,37,747 as to be likely to cause confusion or to cause mistake or to deceive."

8. U.S. Registration Nos. 0,875,802, 1,080,641, 1,119,980, 1,393,578, 1,393,579, 1,42,660, 1,841,031, 1,841,032, 1,823,440, 2,300,509 and 2,298,693 are owned by La Quinta.

9. The Examining Attorney required disclaimer of exclusive rights to the words "La Quinta National Golf Club," in part, on the grounds that "La Quinta" was primarily geographically descriptive. The Examining Attorney also objected to the identification of services as originally filed as indefinite.

10. In response to the Office Action, KSL claimed ownership of U.S. registrations 2,147,965, 2,342,039, 2,367,741 and 2,367,747 and claimed acquired distinctiveness as to the term "LA QUINTA" based upon these registrations.

11. KSL argued against the Examining Attorney's refusal under Section 2(d) based on U.S. Registration Nos. 2,055,687 and 2,057,682 for the marks THE QUARRY AT LA QUINTA and Design and THE QUARRY AT LA QUINTA owned by La Quinta Golf Properties, Inc. of Westlake Village, California by noting that the term "LA QUINTA" was disclaimed in both registrations.

12. KSL amended its identification of services to "providing facilities for recreational activities, namely, golf, tennis and swimming pools; providing golf club services in the nature of a golf course and golf clubhouse facilities; entertainment in the nature of golf tournaments; golf

instruction” in International Class 41 and “resort services, namely, resort hotels, health spas, and restaurant services” in International Class 42.

13. In further response to the Office Action, KSL represented to the Patent and Trademark Office that there was no likelihood of confusion between the use by KSL of its mark for the above-referenced services and the use by La Quinta of its marks for hotel and motel services, stating:

“In the present case, the length of time during and the condition under which there has been concurrent use without actual confusion should play a dominant role. As noted, the applicant’s LA QUINTA mark has been used since the 1920’s. The La Quinta Inns’ mark has been used since the late 1960’s. The respective marks have thus been concurrently used for over 30 years. This may be explained by the fact that the actual services are quite distinct. Applicant’s resort is a high end, luxury resort that consumers would not, in the vast majority of cases, visit without having some knowledge of applicant and its associated services. The registrant’s hotels and motels, on the other end, are at a much lower price point and are not, upon information and belief, destination resorts. This is of record in the registrant’s services as being ‘hotel/motel services.’ A motel is defined as ‘an establishment that provides lodging and parking and in which the rooms are usually accessible from an outdoor parking area.’ Clearly, this is markedly and notably different from a resort hotel.”

14. KSL has now asserted, in a pending action before the United States District Court for the Central District of California, that a likelihood of confusion exists between the use by La Quinta of its marks for hotel and motel services and the use by KSL of its mark for recreation and resort services including golf and country club services, stating:

“Defendants’ [La Quinta’s] use of the La Quinta Inns or La Quinta Inn & Suites names is likely to cause confusion and is likely to mislead and deceive customers as to the relationship between KSL and LQI, and the relationship between their respective goods and services, in violation of Section 32 of the Lanham Act.”

A copy of the complaint filed by KSL in the United States District Court for the Central District of California (hereinafter referred to as "the Complaint") is attached as Exhibit B.

15. If a likelihood of confusion exists, as KSL asserts in its federal suit, then La Quinta is likely to be damaged by the registration of the mark of U.S. Application No. 76/016,329.

16. Based upon KSL's position in its Complaint, the representations made by KSL to the Examining Attorney in Application Serial No. 76/016,329 were false and approval of the present application was obtained fraudulently.

Wherefore, Opposer prays that Application Serial No. 76/016,329 for KSL LA QUINTA NATIONAL GOLF CLUB be rejected, and that the registration of the mark of the application be denied and refused.

A duplicate copy of this Notice of Opposition and the fee in the amount of \$600 as required in Section 2.6(1) are enclosed herewith. If the check is inadvertently omitted, or the amount is insufficient, or should any additional fees under 37 C.F.R. § 2.6 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Assistant Commissioner for Trademarks is authorized to deduct or credit said fees from or to Thompson & Knight Deposit Account No. 20-0821/045233.000103.

Please return the enclosed postcard to evidence receipt of this Notice of Opposition.

Respectfully submitted,

By: William D. Raman
William D. Raman
Jane A. O'Connell
Attorneys for Opposer
La Quinta Worldwide, L.L.C.

THOMPSON & KNIGHT, L.L.P.
1200 San Jacinto Center
98 San Jacinto Boulevard
Austin, TX 78701-4081
(512) 469-6100

Dated: 10/31/02